

In re Application of:

Campbell et al.

Application No.: 10/692,979

Filed: October 24, 2003

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Attorney Docket No.: PIED1110-1

REMARKS

A. Summary of the Invention and Claim Amendments.

The invention provides the art with the discovery that fatty acid esters, such as isopropyl myristate, can be used as pediculocidal agents that rapidly kill ectoparasites such as lice.

Claim 1 has been amended to include a new limitation that at least 80% of ectoparasites are killed within an hour of application of the recited composition. The 80% limitation is supported in the specification by, for example, paragraphs 0020 and 0039.

Claims 1 and 12 are also provided with narrowing limitations, and Claims 9, 11, 20 and 22 are canceled. After amendment, Claims 1,-4, 8, 10, 12-16, 19, 21 and 32 will be pending.

No new matter being added to the Specification, entry of the proposed amendment is therefore requested. The Examiner's consideration of the claims as amended is appreciated.

B. Response to Rejection under Section 102(a) & (e), based on Pearlman.

Claims 1-4, 12-15, and 32 stand rejected under Section 102(a) and (e) based on Pearlman, US Patent No. 6,303,581. Claims 8-11 and 19-22 are acknowledged as being allowable (Applicant notes that Claim 22 was previously canceled, so reads the allowable claims set as being Claims 8-11 and 19-21).

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For the rejected claims, the present and prior Office Actions acknowledge that Pearlman neither teaches nor suggests that fatty acid esters might be pediculocidal within the 1 hour time frame recited. However, the present Action asserts that such teaching is not provided by the present application, except as to the activity of isopropyl myristate, and as to use of the invention against lice.

As to the contention that only lice can be affected by the invention, Applicants submit that the reach of the invention beyond lice has already been established. In particular, in the parent application, claims to use of twelve fatty acid esters (including isopropyl myristate) as the sole pediculocidal agent against not only lice, but also fleas, ticks and other ectoparasites, have been issued.

It is axiomatic that "full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art." MPEP § 706.04, citing *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001). Here, no evidence of such a clear error has been provided nor did one exist (in this respect, it is noted that the present Examiner also allowed the claims of the parent). No question was raised during prosecution of those claims as to extension of the invention's scope to all disclosed ectoparasite targets, and no evidence is of record to suggest that the data supporting use of the invention against lice does not suffice to support the full scope of the claims.

Indeed, the present claims differ from those previously allowed only in not requiring use of a siloxane carrier, and in excluding the use of alcohol. Therefore, the only question not resolved during prosecution of the parent patent is whether the prior art anticipates use of a fatty acid ester without an alcohol as a single agent to kill ectoparasites as presently claimed.

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In that respect, the present Office Action agrees that Pearlman does not teach or show use of a fatty acid ester to kill ectoparasites as presently claimed. However, it is contended that the present application only does so for use of isopropyl myristate.

The latter contention seems more appropriate to consideration under Section 112 than Section 102. As to Section 112, the question of whether the specification supports claims to use of fatty acid esters other than isopropyl myristate was generally resolved in Applicant's favor during prosecution of the parent application.

Nonetheless, for the sole purpose of expediting allowance of the pending claims, and without acquiescence in the present rejections, waiver of Applicants' arguments set forth in their prior Responses submitted herein on August 6, 2008, January 10, 2008 and August 31, 2007, or prejudice to Applicants' right to pursue broader claims, Applicants have amended the present claims to identify isopropyl myristate as the presently claimed active agent. The claims are therefore now in accord with the subject matter identified in the Office Action as not taught in the Pearlman reference; i.e., single agent use of isopropyl myristate in concentrations of at least 10% w/w to kill ectoparasites within an hour of application.

For the foregoing reasons, Applicants respectfully submit that the amended claims are allowable, and that their rejection over Pearlman should be reconsidered and withdrawn.

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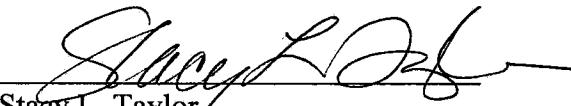
CONCLUSION

All of the pending claims (1-4, 8, 10, 12-16, 19, 21 and 32) are believed to be in condition for allowance. Reconsideration of the claims rejections is therefore requested as outlined above.

The Commissioner is hereby authorized to charge \$960.00 as payment for the Petition for Three-Month Extension of Time fee (\$555.00) and Request for Continued Examination fee (\$405.00) to Deposit Account No. 07-1896. Additionally, the Commissioner is hereby authorized to charge any other fees that may be due in connection with the filing of this paper, or credit any overpayment to Deposit Account No. 07-1896, referencing the above-identified docket number.

Respectfully submitted,

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